

## **REMARKS/ARGUMENTS**

This Amendment and Response is responsive to the Notice of Non-Compliant Amendment dated March 21, 2008, setting forth a one month, or thirty (30) day, whichever is longer, period for response in order to provide a complete listing of claims, including withdrawn claims. This Amendment and Response includes the text of the withdrawn claims and is, therefore, believed to address the concerns in the Notice of Non-Compliant Amendment.

This Amendment and Response is also responsive to the Office action dated October 29, 2007, setting forth a shortened three-month statutory period for reply. The response filed on February 29, 2008, was submitted with a petition for a one-month extension of time to reply and the appropriate fee. This Amendment includes the arguments and amendments set forth in the February 29, 2008 response. No additional fees are believed to be due with this filing.

The Applicant thanks the Examiner for reviewing this application and issuing an Office action.

Claims 28-44, 56-58 and 60-66 are pending in the application, with claim 28 being an independent claim. By this Amendment, claim 44 is amended and claims 56-58 and 60-66 are withdrawn. Accordingly, after entry of this Amendment and Response, claims 28-44 remain pending.

### **I. Election/Restrictions**

Claims 56-58 and 60-66 were not considered by the Examiner based on the Applicant's election of Group II (claims 28-44) following the restriction requirement dated February 27, 2007. In response, claims 56-58 and 60-66 are withdrawn. However, as mentioned in the Office action, the Applicant is entitled to resubmit the claims upon the allowance of claim 28, which is considered generic.

### **II. Double Patenting**

Claims 28 and 43 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 13 and 14 of copending United States

Patent Application No. 11/425079 (hereinafter "'079 application") in view of United States Patent Application Publication 2002/0120705 to Schiavone et al. (hereinafter "Schiavone"). In response, a terminal disclaimer in compliance with 37 C.F.R. 1.311(c) accompanies this response. However, the inclusion of a terminal disclaimer should not be construed as an admission of obviousness in light of the cited references as the claims of the '079 application may likely change in scope during prosecution.

### III. Claim Rejections Under 35 U.S.C. § 101

Claim 44 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, descriptions and expressions of a computer program not encoded on a computer readable medium do not define any structural and functional interrelationships between the computer program and other claimed elements. In response, claim 44 is amended to include "computer-readable medium containing computer-executable instructions." The Applicant believes claim 44 now claims patentable statutory subject matter and respectfully requests the Examiner to remove the rejection of claim 44.

### IV. Claim Rejections Under 35 U.S.C. § 102(e)

Claims 28-31, 33, 34, 40, 42 and 43 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schiavone. Under 35 U.S.C. §102 "[a] claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *MPEP* § 2131. For the following reasons recited below, it is respectfully submitted that Schiavone does not anticipate any of the above listed claims. Initially, the rejection of independent claim 28 is addressed.

#### **A. Independent claim 28 is patentable because Schiavone fails to disclose determining a class to which a frank associated with a communication corresponds.**

Independent claim 28 includes the limitations of "determining whether the communication is associated with a frank, the frank corresponding to a value" and "determining a class to which the frank corresponds." It is respectfully submitted that Schiavone fails to teach these limitations.

Schiavone describes a system for controlling distribution of communications. To control the communications, the system of Schiavone receives an incoming message that "either

carries priority information, or is assigned priority information.” See *Schiavone, Abstract*. Based on the priority information attached to the incoming message, the system in Schiavone determines “how and/or when to deliver the e-mail message.” See *Schiavone, para. 0034*. However, it is respectfully submitted that Schiavone fails to disclose the limitation of determining a class to which the priority flag corresponds.

As described above, Schiavone discloses attaching a priority flag to an incoming message to determine how to deliver the message. However, Schiavone does not disclose an active step of determining a class to which the flag corresponds. The Office action indicates that “priority information can be indicative of a class.” See *Office action, page 6 section 18*. In support of this statement, the Office action relies on paragraphs 0012 and 0017 of Schiavone. However, the examples provided in the relied upon paragraphs merely described types of priority flags, not classes that the priority flags correspond to. For example, Schiavone states:

“[S]uch priority information may include a priority flag, such as “Immediate Action Required,” “For Reference Only,” “For Information Only,” “Highest Priority,” etc., or may include a categorization of the e-mail message, e.g. “Internal Business Communication,” “External Business Communication,” “Personal,” “Friends and Family,” “Bills and Statements,” etc.

See *Schiavone, para. 0017*. In other words, as described by Schiavone, priority of the email can be based on information about the email or a description of the type of email. However, the examples provided above are instances of different priority flags, not classes to which the priority flags correspond. As evident from the above quote, the category of an email, i.e. “Internal Business Communication,” is a priority flag similar to the “Highest Priority” priority flag. Schiavone provides many examples of priority flags, but simply fails to disclose priority flags corresponding to a class.

Irrespective of whether priority flags can be indicative of class, there is no positive step in Schiavone of actively “determining a class to which the flag corresponds,” which would be necessary to support a rejection under 35 U.S.C. §102. Moreover, even if priority is indicative of a class, Schiavone would only describe one class, namely “priority.” Hence, there would be no reason to determine the class to which the flag corresponds because they would all be in the same class. Because Schiavone fails to disclose “determining a class to which the flag corresponds”, Schiavone cannot anticipate this claim.

**B. Dependent claims 29-32, 33, 34, 40, 42 and 43 are patentable because they depend upon and contain all of the limitations of independent claim 28.**

Dependent claims 29-32, 33, 34, 40, 42 and 43 are rejected as being unpatentable over Schiavone. These claims depend upon, either directly or indirectly, and contain all of the

limitations of independent claim 28. As demonstrated above, Schiavone fails to disclose the limitation of determining a class to which the frank corresponds. Therefore, for at least this reason, dependent claims 29-32, 33, 34, 40, 42 and 43 are patentable over Schiavone.

### **C. Conclusion**

For at least the reasons set forth in both sections A and B above, Schiavone fails to disclose all of the limitations of claims 28-31, 33, 34, 40, 42 and 43. Accordingly, it is respectfully submitted that these claims are allowable over the cited art. The Applicant thus respectfully requests that the Examiner withdraw the rejections and allow these claims over the cited reference.

### **V. Claim Rejections Under 35 U.S.C. § 103**

Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schiavone. Claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schiavone in view of United States Patent No. 5,694,616 to Johnson et al. (hereinafter "Johnson"). Claims 36-39 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schiavone in view of United States Patent No. 6,393,464 to Dieterman et al. (hereinafter "Dieterman"). Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schiavone in view of United States Patent No. 6,301,608 to Rochkind (hereinafter "Rochkind").

A proper prima facie obviousness rejection requires that the combined references teach or suggest all of the claim limitations. See *MPEP* § 2143. For the following reasons recited below, it is respectfully submitted that the combined references fail to teach the limitations of the rejected claims.

The Office action rejects dependent claims 32, 35-39, 41 and 44 over Schiavone in combination with Johnson, Dieterman and Rochkind. However, these rejected claims all depend, either directly or indirectly, from independent claim 28. As shown above, Schiavone fails to teach the limitation of determining a class to which the frank corresponds as required by independent claim 28. Similarly, Johnson, Dieterman and Rochkind also fail to teach the limitation of determining a class to which the frank corresponds. Johnson discloses a method for prioritizing the display of emails. Dieterman discloses a method for controlling the delivery of an email based on the characteristics of the sender. Rochkind discloses a method for prioritizing incoming email based on an address extension. However, Johnson, Dieterman and

Rochkind all fail to teach classes for the franks and the limitation of determining a class to which the frank corresponds. Thus, for at least these reasons, dependent claims 32, 35-39, 41 and 44 are patentable over the combined references. Therefore, the Applicants respectfully requests that the Examiner withdraw the rejections and allow these pending claims over the cited references.

### CONCLUSION


After entry of the above listing of claims and remarks, claims 28-44 remain in the application. In accordance with the amendments and arguments set forth herein, the Applicant respectfully submits the application and all claims are in a condition for allowance, and requests such prompt allowance.

The Applicant believes no further fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this as authorization therefor and please charge such fees to Deposit Account number 04-1415.

Should any issues remain that the Examiner believes may be dealt with in a telephone conference, he is invited to contact the undersigned at 303-629-3400.

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Respectfully submitted,



Gregory P. Durbin, Registration No. 42,503  
USPTO Customer No. 20686

DORSEY & WHITNEY LLP  
370 17<sup>th</sup> Street, Suite 4700  
Denver, Colorado 80202-5647  
Telephone: 303-629-3400  
Facsimile: 303-629-3450